

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	§	Filed: August 28, 2003
Birkestrand et al.	§	
	§	Group Art Unit: 2132
Serial No.: 10/650,541	§	
	§	Examiner: Benjamin E. Lanier
Confirmation No.: 9041	§	

For: CAPACITY ON DEMAND GRACE PERIOD FOR INCOMPLIANT SYSTEM  
CONFIGURATIONS

MAIL STOP APPEAL BRIEF - PATENTS  
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November 20, 2008	/Mayra Bravo/
Date	Mayra Bravo

Dear Sir:

**REPLY BRIEF**

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to Examiner's Answer mailed on September 22, 2008. While Applicants' maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Applicants make the following further arguments in light of the Examiner's Answer.

## **ARGUMENTS**

### **1. Claims 28-51 are not anticipated by *Circenis* under 35. U.S.C. 102(e).**

#### *The Applicable Standard*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

#### *The Examiner's Arguments*

On pages 6-8 of the *Examiner's Answer*, the Examiner provides a rebuttal with respect to the *Applicants' Appeal Brief*, and further elaborates on previously submitted arguments, suggesting that Applicants' arguments are not persuasive. In response, Applicants respectfully maintain that each of the arguments presented in *Applicants' Appeal Brief* are correct, and further provide the following arguments in response to the Examiner's Answer.

#### *Applicants' Response to Examiner's Arguments*

#### **Claims 28-51**

In this case, *Circenis* does not disclose "each and every element as set forth in the claim". For example, regarding claim 1, *Circenis* does not disclose recording a compliant state of the computerized apparatus, with respect to the on-demand resource,

in which a system function uses the on-demand resource with authorization, and determining an incompliant state of the computerized apparatus, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization. Claims 36 and 44 recite similar claim limitations.

On page 7 of the *Examiner's Answer*, the Examiner argues that *Circenis* discloses that a “user is permitted to access additional on-demand components outside of what the user has paid for a temporary period. These additional components accessed by the user outside of the matter of right would represent the claimed incompliant state of the computerized apparatus because the user has not been “authorized” to use the on-demand components to the extent that no payment has been received for the use of these components.” The Examiner further states that “the issue of payment in *Circenis* [is relied upon] to meet the claimed authorization features.” See *Examiner's Answer*, pg. 7. In other words, the Examiner's rejection is premised on the assertion that the access of the “additional components” of *Circenis* teaches an incompliant state of a computerized apparatus in which a system function uses an on-demand resource without authorization. Based on the Examiner's arguments, it is the Applicants' understanding that the Examiner is interpreting the claim limitation “authorization” as meaning an access to the “additional components” without payment.

However, *Circenis* explicitly states that these additional components are activated by maintaining an adequate temporary capacity account with the vendor providing the services. See *Circenis*, col. 1, ll. 65 – col. 2, ll. 6. Further, a user maintains a temporary capacity amount by “purchas[ing] temporary capacity with the vendor.” See *Circenis*, col. 1, ll. 65-66. It should be clear that a purchase qualifies as “an issue of payment”. The following passage from *Circenis* should alleviate any doubt:

The user can purchase or replenish the temporary capacity by contacting the vendor using, for example the vendor's website or portal, the telephone or by any other telecommunication or communication means. To purchase temporary capacity, the user may furnish his identification information, the computer system identification information, the amount of temporary capacity desired, and/or any payment information in order to receive a codeword from the vendor.

See *Circenis*, col. 5, ll. 37-45. As is evident, the additional components are accessible by purchasing temporary capacity (*i.e.* providing a payment to the vendor providing the services). Therefore, the access to these additional components are “authorized” in view of the Examiner’s interpretation of the claims.

Therefore, *Circenis* does not disclose recording a compliant state of the computerized apparatus, with respect to the on-demand resource, in which a system function uses the on-demand resource with authorization, and determining an in-compliant state of the computerized apparatus, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization.

Further, because *Circenis* does not disclose using an on-demand resource without authorization, it follows that *Circenis* also does not disclose initiating a grace period during which a system function continues to use the on-demand resource while in the in-compliant state (*i.e.* using a resource without authorization), wherein the computerized apparatus transitions from the compliant state to the in-compliant state and then initiates the grace period in a manner providing continuous availability of the on-demand resource to the system function.

Therefore, Applicants respectfully request the rejection to claims 28, 36, 44, and the claims that depend therefrom be reversed and the claims be allowed.

## CONCLUSION

The Examiner errs in finding that claims 28-51 are anticipated by *Circenis* under 35 U.S.C. § 102(e).

Withdrawal of the rejections and allowance of all claims is respectfully requested.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. McClellan, Reg. No. 44,227/

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Gero G. McClellan  
Registration No. 44,227  
Patterson & Sheridan, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Appellant(s)